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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,966	02/28/2002	Gerald D. Eckstein	8266-0823	3797

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Bose McKinney & Evans LLP
Intellectual Property Group
2700 First Indiana Plaza
135 North Pennsylvania Street
Indianapolis, IN 46204

EXAMINER

KEASEL, ERIC S

ART UNIT

PAPER NUMBER

3754

DATE MAILED: 07/15/2003

129

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/085,966

Applicant(s)

ECKSTEIN ET AL.

Examiner

Eric Keasel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-27 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-27 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Detailed Action*.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 April 2003 has been entered.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 21, 25, 26, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Pilolla (US Patent Number 5,358,213).

Pilolla discloses a valve assembly (10) with a manifold having an inlet (32), outlet (48), and a conduit (72) therebetween. A valve (110, 130) inhibits or permits flow between the inlet and outlet. A lever (182) is pivotally connected to the manifold (see ref. no. 189 and column 5, lines 33-37) and located entirely outside the conduit. A solenoid (140) is positioned between the manifold and lever and directly connected to the valve. The position of the lever is independent of the presence of the electrical input to the solenoid. Fig. 1 shows the valve closed, Fig. 2 shows the valve opened by the manual lever, and Fig. 4 shows the valve opened by electrical actuation of the solenoid (note the lever does not move).

“[F]or a hospital bed”, “for positioning the bed”, “for a support device”, and “for positioning the support device” are intended use recitations. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and

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the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

3. Claims 21, 27, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Pilolla (US Patent Number 5,595,216).

Pilolla discloses a valve assembly (10) with a manifold having an inlet (28 and/or 30), outlet (50), and a conduit (76) therebetween. A valve (110, 130) inhibits or permits flow between the inlet and outlet. A lever (162) is located entirely outside the conduit and has an opening (see Fig. 1) to receive a part of the valve stem (102). A solenoid (140) also moves the valve from the closed to the opened positions. The position of the lever is independent of the presence of the electrical input to the solenoid (see column 7, lines 56 and 57).

“[F]or a hospital bed”, “for positioning the bed”, “for a support device”, and “for positioning the support device” are intended use recitations. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pilolla (US Patent Number 5,358,213) as applied to claim 21 above, and further in view of McNabb (US Patent Number 5,487,493).

Pilolla fails to disclose the lock engaging the lever as a lock bar and a lock solenoid. McNabb discloses lock bar (29) and a lock solenoid (24) moving the lock bar to engage a lever (20) in a similar manual operated valve. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the lock bar and lock solenoid of McNabb in the valve assembly of Pilolla in order to secure the lever in position as taught by McNabb.

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6. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pilolla (US Patent Number 5,595,216) as applied to claim 21 above, and further in view of McNabb (US Patent Number 5,487,493).

Pilolla fails to disclose the lock engaging the lever as a lock bar and a lock solenoid. McNabb discloses lock bar (29) and a lock solenoid (24) moving the lock bar to engage a lever (20) in a similar manual operated valve. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the lock bar and lock solenoid of McNabb in the valve assembly of Pilolla in order to secure the lever in position as taught by McNabb.

Response to Arguments

7. Applicant's arguments with respect to claims 21 and 40 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (703) 308-6260. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene can be reached on (703) 308-2696. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

Eric Keasel 14 JUL 03

Eric Keasel
Examiner
Art Unit 3754

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July 14, 2003